

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Official Action mailed October 24, 2006. This Reply encompasses a bona fide attempt to overcome the rejections raised by the Examiner and presents amendments as well as reasons why Applicant believes that the claimed invention, as amended, is novel and unobvious over the applied prior art. Accordingly, Applicant respectfully requests reconsideration and favorable action in this case.

Claim Status

Claims 2-3, 8, and 24 are amended herein. No claim is cancelled or newly added. By this amendment, Claims 1-31 remain pending.

Claim Objections

Claims 8 and 24 were objected to for minor informalities. As required by the Examiner, Claim 8 is amended herein to properly conclude with a period (".") and Claim 24 is amended herein to add "wherein said secure transaction is selected from" before the words "the group consisting of". Accordingly, withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C. § 112

Claims 2 and 3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, Claims 2 and 3 were rejected for not fully reciting all three words of the claim limitation "transaction authorization token". Claims 2 and 3 are amended herein per the Examiner's instruction on page 3 of the Office Action. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1, 3-5, 7, 13, 14, 17, 22, 25 and 29-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0068629 A1 ("Allen") in view of *Kerberos: An Authentication Service for Computer Networks* ("Neuman"). The rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the rejections failed to meet these three basic criteria for the following reasons:

1. The Examiner has not provided a proper suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. For example, in rejecting Claims 1 and 29, the Examiner alleged the following:

“It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine issuing a token to a user from an application server while online with the service and validating a token, as taught by Neuman et al., with the method of Allen et al. It would have been obvious for such modifications because a token enables a user to login to a service for later use.”

The Examiner did not cite any support on the alleged motivation to combine (i.e., “because a token enables a user to login to a service for later use”), either from the references themselves or from another reference demonstrating that the knowledge was generally available to one of ordinary skill in the art at the time the invention was made. The alleged motivation to combine Allen and Neuman is respectfully submitted to be improper for at least two reasons. First, Allen and Neuman do not teach or describe a token exactly as specified in the present application. See Specification, page 8, lines 4-20. Second, the combined teachings of Allen and Neuman do not appear to explicitly teach or describe that “a token enables a user to login to a service for later use.”

According to Allen, a user/client establishes a network connection between a client computer and a gaming provider server using steps known in the art. See Allen, page 3, paragraph [0035], and page 5, paragraph [0050]. Specifically, a user ID and valid password is submitted from the client computer to the gaming provider server in order to establish the network connection. *Id.* As shown in Figure 4 of Allen, a customer would have to first login to the gaming provider server using the user ID and password before a token can be created. As shown in Figure 6 of Allen, a customer again would have to first login to the gaming provider server using the user ID and password before uploading a token for redemption. In other words, Allen's token has nothing to do with whether a user is able to login to the gaming

provider server. Thus, Allen does not teach or suggest “a token enables a user to login to a service for later use,” as the Examiner has alleged.

Neuman also does not teach or suggest “a token enables a user to login to a service for later use,” as the Examiner has alleged. The Kerberos ticket is a certificate issued by an authentication server, encrypted using the server key, and contains the random session key that will be used for authentication of the principal to the verifier, the name of the principal (i.e., a user) to whom the session key was issued, and an expiration time after which the session key is no longer valid. See Neuman, “The Kerberos Ticket”, page 3, bottom paragraph. Unlike Allen’s token, the Kerberos ticket of Neuman does not have a data field which specifies applications and versions enabled for a particular token. Fundamentally, the Kerberos authentication protocol disclosed by Neuman can be independent of application servers and services. According to Neuman, a client (C) wishing to create an association with a particular verifier (V) first uses the authentication request and response (i.e., messages 1 and 2 from Figure 1 of Neuman) to obtain a ticket and session key from an authentication server (AS). See Neuman, “Authentication request and response”, page 5, top paragraph. The client (C) then forwards the ticket to the verifier (V) as part of an application request (i.e., message 3 in Figure 1 of Neuman). See Neuman, “Application request and response”, page 4, top paragraph. Neuman does not teach or suggest that the verifier (V) issues a ticket, certificate, or token to enable a user to login to a service. What is more, Neuman explicitly discloses authentication for real-time, interactive services that are offered on computer networks. See Neuman, “Authentication, Integrity, Confidentiality, and Authorization”, page 2, top paragraph. Nothing in Neuman teaches or suggests that a ticket enables a user to login to a service for later offline use. Thus, Neuman does not teach or suggest “a token enables a user to login to a service for later use,” as the Examiner has alleged.

Additionally, as evidenced by Neuman’s teaching and consistent with Applicant’s disclosure, at the time the invention was made, services offered on computer networks were concerned with real-time, interactive sessions. See Neuman, *supra*. Access to these online services typically requires network connectivity as well as online identity authentication. As submitted above, Allen and Neuman do not teach or suggest “a token enables a user to login to a service for later use.” Thus, at the time the invention was made, there was no suggestion or motivation of “a token enables a user to login to a service for later use,” in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

2. The Examiner has not provided any support that, by combining Allen and Neuman, there is a reasonable expectation of success in fulfilling the need for a method and system enabling off-line transactions with substantially the same security as PKI, without the requirement of secure network connectivity, and without the need for special PKI software to be run by the end user. On the contrary, the combination of Allen and Neuman cannot reasonably be expected to fulfill the aforementioned need because they are based on fundamentally different technologies. For example, Claims 1 and 29 recite, among others, "issuing a transaction authorization token to a user from an application server for the on-line service while the user is online with the on-line service." The Examiner pointed out that Allen does not teach this limitation but alleged that:

"Neuman et al. teaches issuing a token to a user from an application server for the on-line service while the user is online with the online service (fig. 1, steps 1 and 2) and validating the transaction authorization token (fig. 1, steps 3 and 4) where the validating is performed while the user is off-line from the service (fig. 1, the user is offline from the ticket granting service during validation)."

Applicant respectfully disagrees. As submitted above, according to Neuman, a client (C) wishing to create an association with a particular verifier (V) first uses the authentication request and response (i.e., messages 1 and 2 from Figure 1 of Neuman) to obtain a ticket and session key from an authentication server (AS). See Neuman, "Authentication request and response", page 5, top paragraph. In this case, an application server would be the verifier (V) who demands assurance of the client's identify. The ticket is issued by the authentication server (AS) and *not* by the application server with whom the client wishes to create an association (e.g., establish an account). After obtaining the ticket from the authentication server (AS), the client (C) forwards the ticket to the verifier (V) as part of an application request (i.e., message 3 in Figure 1 of Neuman). See Neuman, "Application request and response", page 4, top paragraph. Contrary to the Examiner's allegation, the ticket granting service is part of the complete Kerberos authentication protocol as shown in Figure 2 of Neuman and not part of the basic Kerberos authentication protocol as shown in Figure 1 of Neuman. Moreover, as submitted above, Neuman discloses authentication protocols for real-time, interactive services that are offered on computer networks. The user of the Kerberos authentication protocols is not "offline from the ticket granting service during validation," as the Examiner has alleged.

In view of the foregoing, it is respectfully submitted that combining Allen and Neuman would not enable off-line transactions with substantially the same security as PKI and there is no reasonable expectation of success that it would.

3. The Examiner has not shown that the prior art references when combined teach or suggest all the claim limitations. For example, as to Claims 1 and 29, in rejecting the claim limitation of “preparing an off-line transaction object containing data to specify and request the secure transaction,” the Examiner cited “all of fig. 5” of Allen. According to Allen, Fig. 5 depicts a flow diagram illustrating a method by which a client executes a gaming application causing modification to a token while the client computer is off-line. See Allen, page 4, paragraph [0043]. The cited portion of Allen does not teach or suggest “preparing an off-line transaction object containing data to specify and request the secure transaction” and particularly lacks any teaching on “preparing an off-line transaction object.” As another example, as to Claims 1 and 29, in rejecting the claim limitation of “sending a message to the on-line service, said message containing the off-line transaction object and the transaction authorization token,” the Examiner cited “fig. 3 and fig. 6, ref. num 610” of Allen. According to Allen, reference number 610 refers to the step where the client uploads the token to the gaming provider server. See Allen, page 5, paragraph [0052]. The cited portion of Allen does not teach or suggest sending a message which contains *both* 1) the off-line transaction object and 2) the transaction authorization token.

In view of the foregoing, it is respectfully submitted that Allen and Neuman when combined do not teach or suggest all the claim limitations as recited in Claims 1 and 29.

For the foregoing reasons, Claims 1 and 29 are respectfully submitted to be allowable over Allen and Neuman under 35 U.S.C. § 103(a). Reliance is placed on *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) for the allowance of dependent Claims 3-5, 7, 13, 14, 17, 22, 25 and 30-31, since they differ in scope from their independent Claims 1 and 29.

Dependent Claims 2, 6, 9-12, 15, 16, 19-21, 23, 24 and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Neuman” and further in view of U.S. Patent Application Publication No. 2002/0010638 (“Fischer”). Dependent Claims 8 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Neuman and further in view of U.S. Patent No. 4,393,269 (“Konheim”). The rejections are respectfully traversed for similar reasons as submitted above with respect to the combination of Allen and Neuman as applied to independent Claims 1 and 29. In addition, reliance is placed on *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) for the allowance of dependent Claims 6, 9-12, 15, 16, 19-21, 23, 24 and 26-28, since they differ in scope from their independent Claim 1, which has been submitted as allowable.

Conclusion

Applicant has now made an earnest attempt to place the present application in a condition for allowance. Other than as explicitly set forth above, this reply does not include any acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, favorable consideration and a Notice of Allowance of all pending claims 1-31 is respectfully solicited. The Examiner is invited to telephone the undersigned at the number listed below for discussing an Examiner's Amendment or any suggested actions for accelerating prosecution and moving the present application to allowance. The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,

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